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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/724,000	11/26/2003	Ralph L. Jenkins	15923-09078 CIP	7961
27530	7590	09/16/2005	EXAMINER	
NELSON MULLINS RILEY & SCARBOROUGH, LLP 1320 MAIN STREET, 17TH FLOOR COLUMBIA, SC 29201			BELLINGER, JASON R	
			ART UNIT	PAPER NUMBER
			3617	

DATE MAILED: 09/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/724,000

Applicant(s)

JENKINS ET AL.

Examiner

Jason R. Bellinger

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 05 July 2005.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 19-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 19-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 7/5/05
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

***Claim Rejections - 35 USC § 102***

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

2. Claims 19, 23, 25, and 29 are rejected under 35 U.S.C. 102(b) as being anticipated by Merriman. In Figures XI through XIII, Merriman shows a vehicle wheel weight having a cold-formed mass portion 42 formed of a non-lead material, namely steel (see column 3, lines 19-21). The mass portion 42 is adapted for juxtaposition against a wheel rim 66. The mass portion 42 further defines a clip securement cavity (formed when the mass portion 42 is folded along line 44).

A spring steel clip 62 includes an extended portion for engaging the wheel rim 66, and an attachment portion 56 inserted into and retained in the clip securement cavity, so that the spring clip 62 is attached to the mass portion 42. An end of the attachment portion 56 of the spring clip 62 is located entirely within the mass portion 42 (see Figures III and XII).

The attachment portion 56 of the spring clip 62 includes at least one surface irregularity (see Figure XIII, and comparative Figure IV) to facilitate retention of the attachment portion 56 in the slot.

The slot extends along the entire axial length of the mass portion 42, and has a generally V-shaped configuration before attachment of the spring clip 62 (see comparative Figure II). The spring clip 62 has a generally C-shaped configuration.

***Claim Rejections - 35 USC § 103***

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

4. Claims 20-21 and 26-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Merriman. Merriman contains all of the limitations as set forth in paragraph 2 above, but does not specify that the mass portion is formed from low carbon or 1008 steel. However, one of ordinary skill in the art at the time of the invention would have found it obvious to use any type of steel to form the mass portion of the wheel weight, dependent upon the physical and chemical properties required for the weight, availability of such material, and cost.

5. Claims 22 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Merriman as applied to claims 19-21, 23, 25-27, and 29 above, and further in view of Maruyama et al. Merriman does not disclose that the mass portion is formed of iron.

Maruyama et al teaches the use of a wheel weight 1 that is formed of a mass of iron. Therefore from this teaching, it would have been obvious to one of ordinary skill in the art at the time of the invention to form the mass portion of Merriman from iron as an equivalent substitution for lead, in order to reduce environmental contamination and/or health issues due to the use of lead wheel weights.

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6. Claims 24 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Merriman as applied to claims 19-21, 23, 25-27, and 29, above and further in view of Brown. Merriman does not show the surface irregularity of the spring clip being at least one hole defined through the attachment portion.

Brown teaches the use of a balance weight having a spring clip 28 having at least one hole 20 defined through an attachment portion 20. Therefore from this teaching, it would have been obvious to one of ordinary skill in the art at the time of the invention to provide the attachment portion of the spring clip of Merriman with through holes as a substitution of equivalent irregularities, for the purpose of increasing the securing interaction between the mass portion of the weight and the attachment portion of the spring clip, thus preventing the clip from being removed from the weight.

### ***Response to Arguments***

7. Applicant's arguments filed 5 July 2005 have been fully considered but they are not persuasive. The Applicant states that pending claims 19-30 of the instant application correspond to claims 23-34 of the 10/620,309 parent application, which are further amended to overcome the Sugayauchi (6,238,005) reference. It should be noted that the Sugayauchi reference was not relied upon in a rejection of the claims of the instant invention. Furthermore, the Merriman, Maruyama et al, and Brown references (previously relied upon to rejection the claims of the instant application) still read on the newly pending claims.

***Conclusion***

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason R. Bellinger whose telephone number is 571-272-6680. The examiner can normally be reached on Mon - Thurs (9:00-4:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Morano can be reached on 571-272-6684. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.


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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Jason R Bellinger  
Examiner  
Art Unit 3617



jrb



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